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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,551	07/06/2001	Alicia Anne Chastain	RSW920010058US1	5014
36736	7590	05/10/2005	EXAMINER LY, ANH	
DUKE W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			ART UNIT	PAPER NUMBER
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DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/900,551	Applicant(s) CHASTAIN ET AL.	
	Examiner Anh Ly	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 November 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 and 16-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 & 16-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 July 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is response to Applicants' response filed on 11/22/2004.
2. Claim 15 is cancelled dated 02/11/2004.
3. Claims 1-14 & 16-27 are pending in this application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-14 and 16-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0035697 A1 of McCurdy et al. (hereafter McCurdy) in view of US Patent No. 6,192,396 B1 issued to Kohler.

With respect to claim 1, McCurdy teaches receiving a user input selecting the text from the electronic book to form selected text (a user enables to receive/obtaining the electronic document or text from the reader device such as electronic book or PDA or notebook or laptop computers and selecting or highlight the text and sending to the recipient: section 0159, 061-0163 and 0176-0177; highlighting the text: sections 0213-0216; also see fig. 8).

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text.

However, Kohler teaches the highlighted text /portions of message to be automatically sent to a designated as intended for selected recipients (col. 7, lines 26-40 and col. 8, lines 1-10; also see col. 1, lines 60-67, col. 2, lines 1-40; also see abstract).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 2, McCurdy teaches a method in a data processing system as discussed in claim 1.

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach displaying a list wherein the designated set of recipients is selected from the list.

However, Kohler teaches a list of intended recipients is displayed (see fig. 7 and col. 6, lines 65-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 3, McCurdy teaches a method in a data processing system as discussed in claim 1.

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach wherein the selected is highlighted text.

However, Kohler teaches highlighting the portion of text and using focus indicator to highlight the selected text (col. 2, lines 30-36; col. 6, lines 28-30).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 4, McCurdy teaches a method in a data processing system as discussed in claim 1.

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach wherein the highlighted text in a different color from unselected, bolded text, and text with a different font type from unselected text.

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However, Kohler teaches using color to differ with the unselected text (col. 6, lines 32-36).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 5, McCurdy teaches storing the highlighted text in a data structure (HTML data structure: sections 0077 & 0186).

With respect to claim 6, McCurdy teaches wherein the data structure is a download file (sections 0085 and 0101-0103).

With respect to claim 7, McCurdy teaches wherein the text is a notated message of text in the electronic book (section 0213).

With respect to claim 8, McCurdy teaches wherein the text is a highlighted passage of text in the electronic book (highlighting the text notes: section 0213).

With respect to claim 9, McCurdy teaches a method in a data processing system as discussed in claim 1.

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach wherein the sending step sends the highlighted text to the designated set of recipients using a communications link.

However, Kohler teaches the highlighted text /portions of message to be automatically sent to a designated as intended for selected recipients (col. 7, lines 26-40 and col. 8, lines 1-10; also see col. 1, lines 60-67, col. 2, lines 1-40; also see abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The motivation being to enable the user automatically to send the selected/highlighted

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text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 10, McCurdy teaches a method in a data processing system as discussed in claim 1.

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach wherein the sending step sends the selected text to the designated set of recipients in an electronic mail message.

However, Kohler teaches the computerized messages such as e-mail (col. 1, lines 48-51).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The

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motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 11, McCurdy teaches a method in a data processing system as discussed in claim 1.

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach wherein the selected text is located in a body of the electronic mail message.

However, Kohler teaches the computerized messages such as e-mail (col. 1, lines 48-51; col. 9, lines 65-67 and col. 10, lines 1-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The

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motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 12, McCurdy teaches a method in a data processing system as discussed in claim 1.

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach wherein the selected text is located in an attachment attached to the electronic mail message.

However, Kohler teaches an attachment attached in an e-mail message (col. 5, lines 60-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The

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motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 13, McCurdy teaches receiving a first user input selecting the text from the electronic book through a communications link to the data processing system (a user enables to receive/obtaining the electronic document or text from the reader device such as electronic book or PDA or notebook or laptop computers and selecting or highlight the text and sending to the recipient: section 0159, 061-0163 and 0176-0177; highlighting the text: sections 0213-0216; also see fig. 8).

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach displaying a list of recipients, receiving a second user input selecting a designated set of recipient from the list of recipients, and sending the highlighted text to each electronic book for a designated set of recipients.

However, Kohler teaches the highlighted text /portions of message to be automatically sent to a designated as intended for selected recipients (col. 7, lines 26-40 and col. 8, lines 1-10; also see col. 1, lines 60-67, col. 2, lines 1-40; also see

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abstract) and a list of intended recipients is displayed (see fig. 7 and col. 6, lines 65-67), for each recipient, at least one portion of the message is associated with recipient, such that at least one recipient does not receive all portions of the message (1, lines 60-65, col. 2, lines 30-40; also see abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 14, McCurdy teaches receiving a first user input selecting the text from the electronic book through a communications link to the data processing system (a user enables to receive/obtaining the electronic document or text from the reader device such as electronic book or PDA or notebook or laptop computers and selecting or highlight the text and sending to the recipient: section 0159, 061-0163 and 0176-0177; highlighting the text: sections 0213-0216; also see fig. 8); and

responsive to user input, sorting the selected text from the at least one remote electronic book using a selection criteria to form sorted text (sorting the list by title, date: section 0340).

McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161-0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach displaying a list of recipients, receiving a second user input selecting a designated set of recipient from the list of recipients, and sending the highlighted text to each electronic book for a designated set of recipients.

However, Kohler teaches the highlighted text /portions of message to be automatically sent to a designated as intended for selected recipients (col. 7, lines 26-40 and col. 8, lines 1-10; also see col. 1, lines 60-67, col. 2, lines 1-40; also see abstract) and a list of intended recipients is displayed (see fig. 7 and col. 6, lines 65-67), for each recipient, at least one portion of the message is associated with recipient, such that at least one recipient does not receive all portions of the message (1, lines 60-65, col. 2, lines 30-40; also see abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the

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teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

With respect to claim 16, McCurdy teaches wherein selection criteria are used to sort and group the selected text (sections 0218 and 0340).

With respect to claim 17, McCurdy teaches wherein the selection criteria includes at least one of popularity, name of a user originating text within the selected text, and subject matter of portions or text within the selected text (section 0340).

With respect to claim 18, McCurdy teaches wherein the selected text includes passages from at least one remote electronic book (section 0213).

With respect to claim 19, McCurdy teaches wherein the selected text includes annotations made by a user (section 0209).

With respect to claim 20, McCurdy teaches wherein the selection criteria are received from a user input (section 0340).

With respect to claim 21, McCurdy teaches wherein the selection criteria are received with the selected text (sections 0218 and 0340).

With respect to claim 22, McCurdy teaches wherein the sorted text excludes a portion of the selected text (section 0340).

Claim 23 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 24 is essentially the same as claim 13 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 13 hereinabove.

Claim 25 is essentially the same as claim 14 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 14 hereinabove.

Claim 26 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.


Claim 27 is essentially the same as claim 1 except that it is directed to a computer program product in a computer readable medium rather than a method, and is rejected

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV or fax to (571) 273-4039. The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John Breene, can be reached on (571) 272-4107 or Primary Examiner Jean Corrielus (571) 272-4032.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: Central Fax Center (703) 872-9306

ANH LY 
May 3rd, 2005


JEAN M. CORRIELUS
PRIMARY EXAMINER